

Appl. No.: 09/837,686
Amdt. dated September 8, 2003
Reply to Office action of July 8, 2003

REMARKS/ARGUMENTS

Applicant received the Office Action dated July 8, 2003, in which the Examiner rejected claims 1-5, 15, 18 and 19 as anticipated by Davis (U.S. Patent No. 6,167,462) and rejected claims 6-14, 16, 17 and 20-25 as obvious over Davis. In this Response, Applicant cancels claim 2, amends claims 1, 3-6, 15-21, and 24-25, and submits new claims 26-31. Based on the arguments and amendments contained herein, Applicant believes all pending claims to be in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and allowance of the pending claims.

As shown in Figure 1 of Davis, Davis is directed to a system 100 in which, among other things, a scanner 114, processing element 102, and keyboard 106 are coupled together via a system bus 104. See also column 2, lines 27-45. Using the system of Davis, network scanner software can be used to access scanners across a network to remotely scan a document. Once a scanner is reserved, no other computer system can access the scanner. See Abstract of Davis. In general, Davis relates to sharing scanners between computer systems across a network.

As amended, independent claim 1 recites an apparatus that comprises "a scanner including a first port and a second port coupled together through a communication bus" and "a keyboard connected to the scanner via the scanner's first port." The keyboard 106 of Davis is shown and described as being connected to a system bus 104, not to a port on the scanner 114. Davis does not teach or even suggest connecting the keyboard to the scanner. At least for this reason, claim 1 is allowable over Davis.

Further, claim 1 requires that the scanner include a first port and a second port (i.e., at least two ports) as well as requiring that the first and second ports are coupled together via a communication bus. Davis does not teach or suggest such a scanner configuration. For these additional reasons, claim 1 is allowable over Davis.

Claims 3-14 depend on or from claim 1 and thus are allowable at least for the same reason as claim 1. Applicant also amends claim 3 to clarify that the

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computer connects to the scanner via the scanner's second port. With the limitations from claim 1, claim 3 thus requires the scanner to include two ports with one port being connected to a keyboard and the other port connected to a computer. Davis does not teach or suggest this configuration.

The dependency links in claims 4-6 and 8 have been changed so as not to refer to cancelled claim 2 and to broaden the scope of the claims where reasonable. Applicant also changed "the computer" limitation in claim 8 to "a computer" to ensure proper antecedent basis.

The Examiner conceded that the keyboard enable logic limitation of claims 6 and 7, the power detector limitation of claim 8, the power supply logic limitation of claim 9 and the keyboard commands limitation of claim 12 are not found within the Davis reference. Office Action, page 4. Despite these admitted deficiencies of Davis, the Examiner concluded that such limitations would have been obvious because "that would provide a user to place a document into the scanner, and select scan from the client software to cause the scanner to scan the document and return the scanned image to the client computer." *Id.* Applicant respectfully submits that the Examiner's conclusion of obviousness is not supported by the stated rationale. For example, there does not appear to be any relationship whatsoever between the claimed power detector being configured to detect a power signal from a computer as in claim 8 and the Examiner's reasons quoted above. The Examiner's stated reasons simply do not support the conclusion of obviousness with respect to the combination of limitations in claims 6-9 and 12. Clarification is respectfully requested if the Examiner intends to maintain the rejection of these claims on this basis.

Method claim 15-21 and 24-25 have been amended to remove all references to "the step of" or the "the steps of." These amendments were not made for reasons of patentability nor to narrow the claims in any way. Instead, these amendments were made to ensure that the claims are not interpreted under the dictates of 35 U.S.C. § 112, sixth paragraph.

Applicant also amended independent method claim 15 to require "connecting a keyboard to the scanner via the communication bus." As explained

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above, Davis does not teach or suggest connecting a keyboard to a scanner. For at least this reason, claim 15 and its dependent claims are allowable over Davis.

Dependent claim 16 is further patentable for requiring detecting whether a power signal is being transmitted from the computer to the scanner. Davis has no such teaching or suggestion.

Dependent claim 17 is further patentable for requiring supplying power to the keyboard from the scanner and for supplying power to the keyboard from the scanner if the power signal from the computer is not detected. Davis has no such teaching or suggestion.

New independent claim 26 is directed to a scanner comprising first and second connections. A user-activated input device can be connected to the first connection and a computer can be connected to the second connection. Davis does not teach or suggest such a scanner configuration. Claim 26 also requires the scanner to comprise control logic that "selectively permits input signals from the input device to be provided to the scanner to control the scanner or permits input signals from the input device to be provided to the computer to control the computer." Davis has no such teaching or suggestion. For either or both of these reasons, claim 26 and its dependent claims are patentable.

Dependent claim 27 introduces an enable control to permit a user to select the input device to be operatively coupled to the scanner or the computer. Claim 29 specifies that the input device can receive power from the scanner or the computer. Claim 29 also requires a power detector that detects whether the computer is providing power to the input device. Claim 30 adds to the subject matter of claim 29 that the power detector causes power to be supplied from the scanner if the computer is not providing power. Claim 31 requires the scanner to comprise a display whereby a user can cause information to be shown on the display via operation of the input device connected to the scanner. Davis does not teach or suggest any of these limitations.

In the course of the foregoing discussions, Applicant may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that

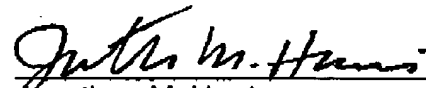
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the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the prior art which have yet to be raised, but which may be raised in the future.

If any fees or time extensions are inadvertently omitted or if any fees have been overpaid, please appropriately charge or credit those fees to Hewlett-Packard Company Deposit Account Number 08-2025 and enter any time extension(s) necessary to prevent this case from being abandoned.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



Jonathan M. Harris
PTO Reg. No. 44,144
CONLEY ROSE, P.C.
(713) 238-8000 (Phone)
(713) 238-8008 (Fax)
ATTORNEY FOR APPLICANT

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
Legal Dept., M/S 35
P.O. Box 272400
Fort Collins, CO 80527-2400

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